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09/747,002

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EXAMINER

ATALA, JAMIE JO

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte WILLIAM B. BOYLE

Appeal 2009-1423
Application 09/747,002
Technology Center 2600

Decided:¹ March 31, 2009

Before JOSEPH F. RUGGIERO, MARC S. HOFF
and ELENI MANTIS MERCADER, *Administrative Patent Judges*.

MANTIS MERCADER, *Administrative Patent Judge*.

DECISION ON APPEAL

¹ The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellant seeks our review under 35 U.S.C. § 134 of the Examiner's final rejection of claims 17-29. We have jurisdiction under 35 U.S.C. § 6(b).

We reverse.

INVENTION

Appellant's claimed invention is directed to a video system and method storing the compressed stream of video data on a storage medium, for example, a hard disk drive (HDD) (Spec. 2:1-2). Modified transport packets are created by adding a predetermined number of bytes to the original transport packets (Spec. 5:19-23). The modified transport packets are stored on a medium that is addressable on sector boundaries (Spec. 5: 24-27). The predetermined number of sectors aligning with the modified transport packets is less than the predetermined number of sectors aligning with the original transport packets (Spec. 5:28-6:6).

Claim 17, reproduced below, is representative of the subject matter on appeal:

17. A method of storing a video data stream on a hard disk drive (HDD) for efficient, non-sequential access to the stored stream of video data, the HDD having a plurality of sectors, each sector having a first integer of user data bytes, the HDD addressable on sector boundaries for non-sequential access, the video data stream including a sequence of original transport packets, each original transport packet having a second integer of bytes, the second integer of bytes different from the first integer of user data bytes, wherein a third integer of original transport packets are storable in a fourth integer of sectors, the fourth integer being a minimum

number of sectors with the same number of user data bytes as the number of bytes in the third integer of original transport packets, the method comprising:

receiving the sequence of original transport packets;

adding a fifth integer of bytes to each original transport packet to create a sequence of modified transport packets, each modified transport packet having a sixth integer of bytes; and

storing the sequence of modified transport packets on the HDD, wherein a seventh integer of modified transport packets are stored in an eighth integer of sectors, the eighth integer being a minimum number of sectors with the same number of user data bytes as the number of bytes in the seventh integer of modified transport packets, the eighth integer of sectors smaller than the fourth integer of sectors.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

| | | |
|----------|-----------------|--|
| Okamoto | US 6,134,384 | Oct. 17, 2000 |
| Morinaga | US 6,792,000 B1 | Sep. 14, 2004 (filed Sep. 26, 2000) |

The following rejection is before us for review:

The Examiner rejected claims 17-29 under 35 U.S.C. § 103(a) as being unpatentable over Okamoto in view of Morinaga.

OBVIOUSNESS ISSUE

Appellant contends that the Examiner ignores features recited in independent claims 17 and 26 regarding the alignment of the first byte in the original transport packet and the modified transport packet (App. Br. 8).

The Examiner asserts that the combination of Okamoto and Morinaga teaches the ability to store transport packets on a hard disk (HDD) (Ans. 10). However, the Examiner did not respond to Appellant's argument regarding the asserted deficiency.

The issue before us, then, is as follows:

Has the Appellant shown that the Examiner erred by determining that the Okamoto and Morinaga combination teaches that the predetermined number of sectors aligning with the modified transport packets is less than the predetermined number of sectors aligning with the original transport packets as recited in independent claims 17 and 26?

FINDINGS OF FACT

The relevant facts include the following:

1. Neither Okamoto nor Morinaga individually or in combination teach that the predetermined number of sectors aligning with the modified transport packets is less than the predetermined number of sectors aligning with the original transport packets.

2. The Examiner has not addressed this limitation in the final rejection nor did the Examiner respond to Appellant's argument on how the Okamoto and Morinaga combination teaches the limitation (Ans. 3-11).

PRINCIPLES OF LAW

The Examiner bears the initial burden of presenting a prima facie case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992). If that burden is met, then the burden shifts to the Appellants to overcome the prima facie case with argument and/or evidence. *Id.* The Supreme Court, citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006), stated that “[r]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007).

“The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art.” *In re Lowry*, 32 F.3d 1579, 1582 (Fed. Cir. 1994).

ANALYSIS

Claim 17 recites “*the fourth integer being a minimum number of sectors with the same number of user data bytes as the number of bytes in the third integer of original transport packets . . . and storing the sequence of modified transport packets on the HDD . . . the eighth integer being a minimum number of sectors with the same number of user data bytes as the number of bytes in the seventh*

integer of *modified transport packets, the eighth integer of sectors smaller than the fourth integer of sectors*” (emphasis added). Neither Okamoto nor Morinaga individually or in combination teaches that the predetermined number of sectors aligning with the modified transport packets is less than the predetermined number of sectors aligning with the original transport packets (Finding of Fact 1). Furthermore, the Examiner has not addressed this limitation in the final rejection nor did the Examiner respond to Appellant’s argument on how the Okamoto and Morinaga combination teaches the limitation (Finding of Fact 2). Thus, the recited claim 17 and commensurate limitation in claim 26 was not considered in determining patentability of the invention over the prior art. *Lowry*, 32 F.3d at 1582.

For the above reasons, Appellant has shown error in the Examiner’s rejection of claims 17 and 26 under 35 U.S.C. § 103(a). We are therefore likewise persuaded of error in the Examiner’s obviousness rejections of claims 18-25 and 27-29 under 35 U.S.C. § 103(a) for similar reasons as these claims depend directly or indirectly from independent claims 17 and 26.

CONCLUSION OF LAW

Under 35 U.S.C. § 103(a), Appellant has shown that the Examiner erred by determining that the Okamoto and Morinaga combination teaches that the predetermined number of sectors aligning with the modified transport packets is less than the predetermined number of sectors aligning with the original transport packets as recited in claims 17 and 26. Furthermore, dependent claims 18-25 and 27-29 fall with claims 17 and 26.

Appeal 2009-1423
Application 09/747,002

ORDER

The decision of the Examiner to reject claims 17-29 under 35 U.S.C.
§ 103(a) is reversed.

REVERSED

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